

Application No.: 09/678570

Case No.: 55409US002

**Remarks**

Claims 1-37 are pending in the application. In the previous Office Action dated March 8, 2004, the Examiner made a restriction requirement, in response to which the applicants provisionally elected Group I, consisting of claims 1-16 and 32-33. Applicants hereby affirm the election of Group I.

Claim 1 has been amended to incorporate the limitations of claims 3 and 4, i.e., that the polymeric sheet material comprises an aliphatic polyurethane and has a percent elongation of about 60% or greater. Support for this amendment may be found in original claims 3 and 4. Claim 1 has also been amended to clarify that the method of finishing the brightwork is for the exterior exposure of the brightwork. Support for this amendment may be found in original claim 1.

In accordance with the changes described above, claims 3 and 4 have been cancelled, and claims 17-31 and 34-37 have been withdrawn from consideration; thus claims 1, 2, 5-16 and 32-33 are currently at issue.

**§ 103 Rejections**

Claims 1-16 and 32-33 stand rejected under 35 USC § 103(a) as being unpatentable over Hoogstoel (U.S. 3,607,540) in view of the specification.

Hoogstoel is directed to the application of adhesive coated wallpaper to a substrate. Although Hoogstoel reports that the substrate may be wood, the outcome of the method of Hoogstoel is to apply wallpaper in order to completely cover the wood substrate. Hoogstoel does not teach or suggest a method of finishing wood or brightwork on a boat with a polymer sheet material for *exterior exposure* of the wood or brightwork.

By contrast, Applicants' claimed method as amended herein, is a method of finishing brightwork on a boat for the exterior exposure of the brightwork. That is, the wood or brightwork is not covered, but is exposed and can be viewed by an observer. The method of Hoogstoel would not be appropriate where it is desirable to view the brightwork, rather, the method of Hoogstoel would mask or cover the wood and would not leave it exposed.

Application No.: 09/678570

Case No.: 55409US002

Further, Hoogstoel does not teach or suggest a flexible polymeric sheet material comprising an aliphatic polyurethane, wherein the sheet has a percent elongation of about 60% or greater. In the Office Action dated March 8, 2004, the Examiner states that "it is conventional in the art to form a backing film from a flexible aliphatic polyurethane having the recited elongation," (see 3/8/04 Office Action at page 4, last paragraph), however, applicants wish to remind the Examiner that in order to establish a prima facie case of obviousness, all of the claimed limitations must be taught or suggested by the prior art (see MPEP 2143.03). The Examiner states that various aspects of the invention are "conventional in the art" however, no specific reference teaching or suggesting the elements has been provided.

In light of the arguments and amendments above, applicants assert that the rejection of claims 1-16 and 32-33 under 35 USC § 103(a) as being unpatentable over Hoogstoel has been overcome and should be withdrawn.

Claims 1-2, 5-12, 15-16 and 31-32 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Moriya et al. (U.S. 5,256,472) in view of the specification.

Moriya et al. discloses a fluorine resin type weather-resistant film comprising a front surface layer made of a composition comprising 50 to 95 parts by weight vinylidene fluoride resin and from 5 to 50 parts by weight of a methacrylate resin, and a rear surface layer made of a composition comprising from 50 to 95 parts by weight of a methacrylate resin and from 5 to 50 parts by weight of a vinylidene fluoride resin and from 0.1 to 15 parts by weight of an ultraviolet absorber.

Moriya et al. does not teach or suggest a polymeric sheet material comprising an aliphatic polyurethane having a percent elongation of 60% or greater as described in the amended claims of the present invention. Moreover, a film made of significant amounts of methacrylate as taught by Moriya et al. would necessarily be less flexible than the films of the claimed invention. Applicants have discovered a material that advantageously exhibits the flexibility necessary to cover highly curved surfaces, such as the brightwork on a boat.

Moriya et al. does not teach or suggest a film comprising an aliphatic polyurethane having a percent elongation of 60% or greater, and thus does not render the claimed invention obvious.

Application No.: 09/678570

Case No.: 55409US002

In light of the arguments above, the rejection of claims 1-2, 5-12, 15-16 and 31-32 under 35 USC § 103(a) as being unpatentable over Moriya et al. has been overcome and should be withdrawn.

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application is requested.

Allowance of claims 1-2, 5-16, and 32-33, as amended, at an early date is solicited.

Respectfully submitted,

June 8, 2004

Date

By: Pamela L. Stewart

Pamela L. Stewart, Reg. No.: 45,707  
Telephone No.: (651) 733-2059

Office of Intellectual Property Counsel  
3M Innovative Properties Company  
Facsimile No.: 651-736-3833